REMARKS/ARGUMENTS

Reconsideration of the application is respectfully requested for the following reasons:

Rejection of Claims 17-21 Under 35 U.S.C. §102(b)

Claims 17-21 are rejected under 35 U.S.C. §102(b) as being anticipated by Kim (US 4,999,310).

Applicant respectfully traverses this rejection since Kim fails to disclose every element of the claimed invention.

Particularly, Kim fails to show a transparent layer having Zn dopants therein on an uppermost layer of a LED substrate, wherein the transparent layer is composed of a semiconductor compound different to that of the uppermost layer. Examiner states that Kim discloses a LED device comprising a LED substrate 21 having an uppermost layer 28, and a transparent layer 24 having Zn dopants thereon on the uppermost layer 28 of the LED substrate 21. However, this description is not what Kim actually teaches. As shown in Figs 3A and 4E of Kim, the n-type GaAlAs layer 24 which is interpreted as a transparent layer by Examiner is not formed on the P-type electrode 28 which is interpreted as an uppermost layer by Examiner. Although Examiner is entitled to give the broadest interpretation of the pending claims 17-21 according to MPEP 2111, this broadest interpretation of the pending claims 17-21 should still be reasonable and consistent with the specification. Assuming that the n-type GaAlAs layer 24 and the P-type electrode 28 of Kim are similar to the transparent layer 24 and the uppermost layer 28 of the claimed invention is unreasonable and inconsistent with the specification of the

claimed invention since the n-type GaAlAs layer 24 is not formed on the P-type electrode 28.

Examiner may suggest that the uppermost layer of the claimed invention must be interpreted and gave its "plain meaning" so that the P-type electrode 28 of Kim is similar to the uppermost layer since the P-type electrode 28 is the top or uppermost layer on the LED device of Kim according to MPEP 2111.01. However, the uppermost layer of the claimed invention has been cleared defined in the specification, drawings and the claim language of the pending claims 17-21. According to 2111.01 Plain Meaning [R-3], THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS THEY ARE DEFINED IN THE SPECIFICATION. While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, **>367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)< (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation.). This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004). That is, assuming that the n-type GaAlAs layer 24 and the P-type electrode 28 of Kim are similar to the transparent layer 24 and the uppermost layer 28 of the claimed invention is unreasonable and actually ignores applicant's clear definition in the specification.

Kim fails to show a transparent layer having Zn dopants therein on an uppermost layer of a LED substrate, wherein the transparent layer is composed of a semiconductor compound different to that of the uppermost layer. Therefore, Kim actually fails to disclose every element of the claimed invention. According to MPEP 2131 Anticipation — Application of 35U.S.C. 102(a), (b), and (e) [R-1] TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus Kim is insufficient to render claims 17-21 unpatentable.

Rejection of Claims 22-25 Under 35 U.S.C. §103(a)

Claims 22-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kim in view of Akaike (US 2002/0036296).

This rejection is respectfully traversed because the combination of Kim and Akaike fails to show all element of the claimed invention. Although Akaike may disclose a GaP uppermost layer, Akaike still fails to teach the elements which Kim does not teach. The combination of Kim and Akaike is still insufficient to render the claimed invention unpatentable since the combination of Kim and Akaike fails to show all element of the claimed invention according to the reasons set forth. According to MPEP §2143, Basic Requirements of a Prima Facie Case of Obviousness[R-1], To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). That is, according to the last basic criteria of MPEP §2143, the teachings of Kim and Akaike actually fail to teach or suggest all the claim limitations. Therefore, the teachings of citations are actually insufficient to render the claimed invention unpatentable and thus Claims 22-25 are patentable over Kim and Akaike.

Conclusion

In light of the above remarks to the claims, Applicant contends that Claims 17-25 are patentable thereover. The claims are in condition for favorable consideration and Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

This Amendment was prepared by Applicant, and is being submitted without substantive change by the undersigned Attorney.

Respectfully submitted,
For: Rosenberg Klein & Lee

David I. Klein
Registration No. 33,253

Dated: 6 Dec 2005

Rosenberg, Klein & Lee
3458 Ellicott Center Drive, Suite 101
Ellicott City, MD 21043
(410)465-6678
Customer No. 04586

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office, Art Unit #2822, at (571) 273–8300, on the date shown below.

For: ROSENBERG, KLEIN & LEE

DAVID I. KLEIN

12/6/2005
Date